

REMARKS

The Final Office Action of January 31, 2008, has been considered by the Applicants. Claim 1 has been amended. New claims 35-37 have been added. Claims 1, 4-8, and 10-37 will be pending in the Application upon entry of this Amendment. Reconsideration of the Application is requested.

Claims 1, 7, 12-17, 19-24, and 27-30 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Ebert (GB 2151201) in view of Monte (U.S. Patent No. 5,578,336) and Brox (U.S. Patent No. 4,780,316). Applicants traverse the rejection.

On page 7 of the Office Action, the Examiner was unable to understand why it mattered whether Ebert GB 2151201 or Ebert US 4,532,126 was cited. In response, Applicants did not assume that the two references were completely identical and were unable to discern whether the Examiner was applying subject matter in GB 2151201 that was not present in US Patent No. 4,532,126. It appears from the Examiner's response that the Examiner is merely applying the same subject matter and is only citing it from a different publication.

Applicants argued that Ebert's disclosure of drying did not inherently or explicitly teach the claimed aging temperature (30 - 40°C) or the claimed aging time (5 hours or more). Furthermore, the aging temperature and time are critical to the formation of V-type crystal in the fill material. Applicants also argued that Brox did not provide a motivation to store the capsule for the claimed aging temperatures or time.

On page 8 of the Office Action, the Examiner stated that one cannot show nonobviousness by attacking references individually where the rejections are based on a combination of references, citing *In re Keller*. In response, *Keller* does not apply. First, one may attack a reference individually as not teaching a particular claim limitation if the Examiner relies on the individual reference for the teaching of that claim limitation. Then, the combination of references is still being attacked. Here, the Examiner relied on Ebert and arguably Brox. Applicants argued that (i) Ebert did not teach the claimed aging times or temperatures; and (ii) there was no motivation to combine Ebert with Brox. Applicants have thus argued against the combination of references. Second, the Examiner stated that the burden was shifted to Applicants to show that Ebert does not

teach drying the capsule at the claimed temperatures. In other words, the Examiner asked Applicants to address the individual reference and Applicants did so.

On page 8 of the Office Action, the Examiner stated that the present claims do not recite the temperature and time that are indicated "critical." According to the Examiner, the specification discloses that (i) hardness immediately falls right after 35°C and (ii) V-type cacao butter is aged for 16 hours. Thus, the Examiner concluded that limitations beyond 35°C and 16 hours do not result in unexpected results. Applicants first note that temperature and time elements are recited in independent claim 1; it appears that the Examiner is merely questioning whether their breadth is critical.

In response, as to the temperature and with respect to Figure 2 of the instant application, Applicants do not regard just the peak point of 35°C as critical, but the range around that peak to be critical as well. The Examiner appears to agree with Applicants that temperatures up to 35°C should be considered critical, but does not believe the temperatures beyond 35°C are. Please note that those temperatures beyond 35°C result in the same hardness as those temperatures up to 35°C. Applicants submit that the Examiner's reasoning as to criticality also applies to those temperatures beyond 35°C.

As to the time, the Examiner referred to Figures 2 and 4. However, for Figure 3, the fill materials were subjected to aging at 35°C for up to 64 hours. As shown in Fig. 3 and noted in the paragraph beginning on page 20, line 21 of the specification, the effect of the aging time eventually becomes saturated. Thus, a time element beyond 16 hours is shown and still results in a critical hardening of the fill material.

Applicants submit that the temperature and time elements of claim 1 should be considered critical. In addition, Applicants have added new claim 35 which recites the time and temperature elements specifically referred to by the Examiner, and request a determination as to whether claim 35 would be allowable.

On page 9 of the Office Action, the Examiner stated that the test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art. Brox was cited solely for the showing that regular storage temperature falls within the claimed aging temperature. Brox, in Examples 7 and 8, stored his test capsules at 20°C, 30°C, and 40°C for 3.5 months.

In response, Applicants submit that Brox does not teach a “regular” storage temperature that is commonly used. Please note that in Examples 5 and 6, Brox stored at 20°C for at least 9.8 months; see col. 4, lines 28-63. Please note as well that 30°C, 35°C, and 40°C are equal to 86°F, 95°F, and 104°F, respectively. These two facts suggest that Brox stored at 30°C and 40°C to speed up his test results, not because they are “regular” storage temperatures, and that storage at 20°C is “normal”. In other words, Brox does not provide motivation to store at the claimed temperature range. Applicants are not aware of any soft chewable capsules that generally require storage at elevated temperatures such as 86°F-104°F. While such temperatures might occur due to weather conditions, these conditions cannot be controlled, so the claimed capsules would not be consistently, reliably produced as they can be when part of the manufacturing process. If storage at elevated temperatures such as 30°C-40°C does occur, Applicants submit that it is accidental, rather than intentional. Accident cannot be considered motivation to arrive at the claimed product.

In summary, Applicants submit that the combination of Ebert, Monte, and Brox do not render the instant claims obvious because the references do not motivate one to age the capsule for the times and temperatures recited in claim 1. Applicants request withdrawal of the § 103(a) rejection based on Ebert, Monte, and Brox.

Claims 1, 4-7, 11, 12, 15-17, 19-30 were rejected under 35 U.S.C. 103(a) as allegedly being obvious over Ebert in view of Cavanak (U.S. Patent No. 5,639,724) and Brox. Applicants traverse the rejection.

The references do not teach all claim elements and there is no motivation to combine the references. In particular, there is no motivation to combine Ebert and Brox, as discussed above. Cavanak is used only to teach the fill material and does not remedy the deficiencies in Ebert and Brox. Applicants request withdrawal of the § 103(a) rejection.

Claim 10 was rejected under 35 U.S.C. 103(a) as allegedly being obvious over Ebert in view of Monte or Cavanak and Nishizawa (U.S. Patent No. 4,463,024). Applicants traverse the rejection.

Claim 10 depends from claim 1. If claim 1 is not obvious, then neither is claim 10. MPEP § 2143.03; *In re Fine*. Applicants do not separately argue the patentability of claim 10. Applicants request withdrawal of the § 103(a) rejection.

Claims 1, 4-7, 11, 12, 15-17, 19, 20, 22, and 24-30 were rejected under 35 U.S.C. 103(a) as allegedly being obvious over Lech (U.S. Patent No. 6,027,746) in view of Cavanak. Applicants traverse the rejection.

Applicants previously argued that Lech does not suggest a reason why they should be stored at such temperatures and does not teach the desirability of the instant claims. Coincidence cannot be considered motivation to arrive at the claimed product.

On page 11 of the Office Action, the Examiner stated that the present claims do not recite any reason why the claimed capsule has to be aged at a certain temperature. In response, motivation to make the claimed invention is not a requirement for patentability, it is a requirement to combine references for a case of *prima facie* obviousness. Applicants must provide the structure for a composition claim, and have done so. To expedite prosecution, Applicants have amended claim 1 to provide a reason for aging: to homogenize the shell and fill material. Support can be found in the paragraphs beginning on page 3, line 6; page 20, line 21; and page 38, line 28.

On page 11 of the Office Action, the Examiner stated that the aging step is an intended future use. Applicants are not sure what is meant by this statement, as both Applicants and the Examiner are treating the aging step as a claim limitation and intended use is generally not given patentable weight. Here, the aging step changes the structure of the chocolate base fill material and therefore has patentable weight. Applicants do not recite an intended use for the soft capsule.

On page 12 of the Office Action, the Examiner stated that the comparison data does not appear to present any unexpected result over the claimed aging parameters. The Examiner also stated that in Fig. 4, the data showed that the improved product results in an even more unpleasant sensation from the shell, as well as more bitterness of fill material and asked whether this was the desirability of the present invention.

In response, the Examiner interpreted Fig. 4 incorrectly. The improved product had a higher value on the y-axis. As explained in Table 1 on page 23 of the

specification, a higher value means that the unpleasant sensation and bitterness decreased. The answer to the Examiner's question is YES, superior taste is one desired result of the present invention.

Fig. 4 compared products without aging against products with aging and found that the aged products had less unpleasant sensation, less bitterness, increased total sensation, and increased usability. The Examiner appears to say that such results were expected from the prior art. However, as discussed above, the prior art would not have produced the aged products. Therefore, the results are unexpected.

There is no motivation to combine the teachings of Lech and Cavanak. The claimed product is therefore not obvious. Applicants request withdrawal of the § 103(a) rejections based on Lech and Cavanak.

Claims 8, 12-16, and 31-34 were rejected under 35 U.S.C. 103(a) as allegedly being obvious over Lech, in view of Cavanak and Katsuragi et al. (U.S. Patent No. 5,756,543).

Claims 17 and 18 were rejected under 35 U.S.C. 103(a) as allegedly being obvious over Lech in view of Mehta (U.S. Patent No. 5,084,278).

These two rejections are traversed together.

These rejected claims all depend from claim 1. Applicants have argued above that the references do not suggest the desirability of the instant claims. Applicants do not separately argue the patentability of these claims. Applicants request withdrawal of the § 103(a) rejection.

Applicants also submit two new independent claims 36 and 37 for the Examiner's consideration. Claim 36 contains the subject matter of original claims 1, 2, 10, and 24. Such a claim was discussed with the Examiner on March 29, 2005. Claim 37 recites additional process steps, in particular requiring the aging step to be performed in a drying chamber. This claim precludes any suggestion that storage can be considered equivalent to aging.

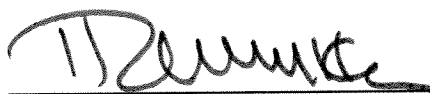
CONCLUSION

For the reasons given above, it is respectfully submitted all pending claims (1, 4-8, and 10-37) are now in condition for allowance. Withdrawal of the rejections and issuance of a Notice of Allowance is requested.

In the event the Examiner considers personal contact advantageous to the disposition of this case, she is hereby authorized to call Richard M. Klein, at telephone number 216-861-5582, Cleveland, OH.

Respectfully submitted,

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June 18, 2008
Date

Certificate of Mailing

Under 37 C.F.R. § 1.8, I certify that this Amendment is being

- ☐ deposited with the United States Postal Service as First Class mail, addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.
- ☒ transmitted to the USPTO by electronic transmission via EFS-WEB on the date indicated below.

Date
June 18, 2008

Signature

Printed Name
Lynda S. Kalemba

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